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EXAMINER	
ZURITA, JAMES H	
ART UNIT	**PAPER NUMBER**
3625	

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/036,998	WILLIAMS, L. LLOYD	
	Examiner	Art Unit	
	James H. Zurita	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-17* is/are pending in the application.

4a) Of the above claim(s) *3-9,11,13,16 and 17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2,10,12,14 and 15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 November 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Prosecution History

The following is provided to clarify the record.

On 21 December 2001, applicant filed the instant application with 31 claims. The application was published on 26 June 2003 as PG-PUB 2003/0120553A1.

On 26 June 2002, applicant submitted a first preliminary amendment. Applicant cancelled claims 3 and 9. Applicant amended claims 5-7. Applicant added claims 10-21; the Office entered these claims as claims 33-44 under 37 CFR 126.

On 23 July 2003, applicant submitted a second preliminary amendment, where he cancelled claims 19-32; these claims are the subject of divisional application 10/625326, filed 23 July 2003. Applicant submitted an amendment to correct paragraph numbers of PG-PUB 2003/0120553A1. Claims 1-18 were pending.

On 6 April 2005, the Examiner issued an Election/Restriction Requirement for claims 1-18.

On 6 May 2005, applicant cancelled claim 18 and elected claims 1, 2, 10, 12, 14-15 without traverse. Claims 1-17 remained pending, of which claims 3-9, 11, 13, 16-17 are drawn to a non-elected invention.

On 2 November 2005, the Examiner issued a non-final rejection of claims 1, 2, 10, 12, 14-15 as unpatentable over Karas (PG-PUB 20020138363 in view of Elliott (US 6,614,781).

On 2 November 2005, applicant filed a response to the office action.

Response to Amendment

Applicant's amendment of 2 November 2005 has been entered. Applicant cancelled claim 1. Applicant amended claims 2, 6, 10, 14 and 15.

Claims 2-17 are pending, of which claims 3-9, 11, 13, 16-17 are drawn to a non-elected invention.

Claims 2, 10, 12, 14-15 will be examined.

Election/Restrictions

Applicant's election of Invention I.d (claims 1, 2, 10, 12, 14, 15) in the reply filed on 6 May 2005 is again acknowledged. Please note the absence of traverse:

> ***Elections/Restrictions***
>
> The Office Action required restriction of claims 1-18 on file in this application.
>
> The claims have been restricted to claims 1-17 drawn to a method for providing electronically mailable pre-paid call credits. Claim 18 is cancelled. Applicant reserves the right to file a divisional application incorporating the subject matter of claim 18.
>
> The Office Action has further required that Applicant select a species. Applicant selects species 1.d.
>
> This application is now considered to be in a condition for examination on its merits.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

At the onset, the Examiner notes that Karas is presented as disclosing applicant's mailable prepaid call credits. Karas also discloses deducting value from prepaid accounts. Karas does not disclose the specifics of telephone billing and prepaid call credits; these features are part of telephone billing systems.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karas PG-PUB 20020138363.

As per claim 2 Karas discloses methods for providing electronically mailable prepaid credits, including the following steps:

(a) receiving from a customer at an application server via a data network, a purchase order of a specified purchase value for the pre-paid credits. See, for example, at least Fig. 6, step 604.

(b) collecting and verifying payment information to collect payment for the purchase value. See, for example Fig. 6, step 616 and related text. see also references to user databases 324, 412, 416.

(c) issuing at the application server an electronic certificate for the purchase value of the credits, the certificate including purchase value (paragraph 19), an unique identifier (paragraph 54) for identifying the purchase order and an email address of a recipient of the credits designated by the customer in the purchase order. See, for example, at least Fig. 6and step 624, concerning sending a greeting card to a recipient via e-mail. See also paragraph 3 concerning sending greeting cards via e-mail.

(d) storing information in a database. See at least paragraph 34, and also references to databases 324, 412, 416.

(e) sending a copy of the electronic certificate to the recipient via email using the email address. See, for example, at least Fig. 6, reference 624.

(f) sending a copy of the electronic certificate to the recipient via email using the email address (Fig. 6, reference 624, for example)

As per claim 2 Karas suggests using his prepaid credits may be for a stored value fund, a foreign currency credit, a prepaid credit or debit card, a ***prepaid phone card***. Paragraphs 19, 24, 31, for example. These are applicant's prepaid call credits. Karas discloses that the electronic [ownership] certificate includes an one or more *icons or buttons or links* may be presented and clicked on that forward a user to a target merchant for using gift certificate and associated credits.

Karas ***does not*** specifically that the electronic [ownership] certificate includes a [call] icon used for initiating calls to be charged against ***prepaid call credit***s associated with the electronic certificate. Official Notice is taken that prepaid call credits in a prepaid phone card may be redeemed by merchants such as telephone call carriers.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Karas and knowledge generally known information to disclose that an electronic [ownership] certificate includes a [call] icon used for initiating calls to be charged against ***prepaid call credit***s associated with the electronic certificate.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Karas and knowledge generally known information to disclose that an electronic [ownership] certificate includes an icon used for initiating calls to be charged against ***prepaid call credit***s associated with the electronic certificate for the obvious reason that by doing so, a user of a prepaid call card may effectively use the telephone system and make use of his prepaid call credits.

Claims 10, 12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karas PG-PUB 20020138363 in view of Elliott (US 6,614,781).

As per claim 10, Karas discloses that prepaid phone credits may be redeemed by appropriate handlers, as in Fig. 2, item 160-1 for prepaid phone card accounts.

Karas ***does not*** provide specific examples of redeeming prepaid call credits:

- receiving at an application server a call request as a result of an action by the recipient who activates the call icon [Karas, paragraph 19, 24 and 31, for example], the call request including the unique identifier, a calling telephone number, an electronic mail address of the recipient and a telephone number of a party to be called by the recipient;
- verifying the electronic certificate using the unique identifier to locate the information stored in the database. See, for example, at least Karas, paragraph 52.
- sending a call request message to a call control node in a switched telephone network to instruct the call control node to initiate actions in the switched telephone network to establish a telephone connection between the calling telephone number

and the called telephone number. See references to activating a purchase to a merchant, as in handler 160-1, prepaid phone card. Karas, paragraph 57 concerning selection of merchant (i.e., phone call handler for switched telephone network, for example).

These detailed features of requesting and placing a phone call over various networks is disclosed by Elliott. For example, Elliott discloses:

(a) *using* a calling telephone number, an Internet Protocol (IP) address (see at least Col. 112, line 64-Col. 113,line 30) of the recipient and a telephone number of a party to be called by the recipient. See, for example, at least references to CDR (call detail record), which includes both telephone numbers. See references to CDR database, Col. 47, lines 7-39.

(c) *sending* a call request message to a call control node (as in call control server, Col. 140, lines 14-58) in a switched telephone network (col. 1, lines 23-44, for example) to instruct the call control node to initiate actions in the switched telephone network to establish a telephone connection (see, for example, initiating a call in an SS7 telecommunications network, at least Col. 2, lines 29-Col. 3, line 8) between the calling telephone number and the called telephone number (see references to called and calling parties, as in Col. 2, lines 51-Col. 3, line 8).

As per claim 12, Karas does not disclose that a call request message sent to the call control node includes the calling and called telephone numbers and a maximum call duration determined using a remaining value of the call credits and the unique

identifier. Karas ***does not*** provide details for handling telephone numbers and call duration.

Elliott discloses that a call request message sent to the call control node includes the calling and called telephone numbers (see references to CDR, call detail record) and a maximum call duration determined using a remaining value of the credits and the unique identifier. See, for example, at least references to usage cap limits, as in Col. 224, line 39-Col. 226, line 31.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Karas and Elliott to disclose that a call request message sent to the call control node includes the calling and called telephone numbers and a maximum call duration determined using a remaining value of the credits and the unique identifier. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Karas and Elliott to disclose that a call request message sent to the call control node includes the calling and called telephone numbers and a maximum call duration determined using a remaining value of the credits and the unique identifier for the obvious reason that different industries may have different ways for charging for their services. In a telephone system, for example, it is important to charge by call duration.

As per claim 14, Karas ***does not*** specifically disclose reporting from the call control node to the application server an actual call duration after the telephone communication is completed or is terminated by the CCN after the maximum call duration has expired.

This feature is disclosed by Elliott, for example, who refers to call duration, as in Col. 1, lines 22-56. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Karas and Elliott to disclose reporting from the call control node to the application server an actual call duration after the telephone communication is completed or is terminated by the CCN after the maximum call duration has expired.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Karas and Elliott to disclose reporting from the call control node to the application server an actual call duration after the telephone communication is completed or is terminated by the CCN after the maximum call duration has expired for the obvious reason that telephone service is often measured and billed by actual duration of a call.

As per claim 15, Elliott discloses

(a) *receiving* at the application server from the call control node via the data network a call duration report associated with the unique identifier. See, for example, at least Col. 20, lines 14-36. See also references to reporting and billing, as in Col. 234, line 37-Col. 236, line 3.

(b) *retrieving* at the application server from the database the information associated with the unique identifier, as in paragraph 54,which shows an identifier matched with a database record of paragraph 34.

(c) *calculating* a charge for the telephone call using the call duration. See at least paragraph 37 and other references to billing function.

(d) *deducting* the charge from the remaining value of the credits to yield an updated remaining value. See at least Karas, paragraph 37, concerning deducting charges from a transfer. See also Fig. 8, reference 884.

(e) storing the updated remaining value of the credits in the database with the information associated with the unique identifier. See at least Karas, paragraph 37, concerning deducting charges from a transfer.

Response to Arguments

Applicant's arguments have been very carefully considered.

Concerning the Election/Restriction Requirement, Applicant argues:

> The Office Action expresses an opinion that Applicant elected the invention I.d without traverse. Applicant respectfully disagrees. The election of species I.d was a species election. As set forth in the Office Action, upon allowance of a generic claim, Applicant will be entitled to consideration of these species claims. In the response dated May 6, 2005, Applicant cancelled claim 18. This was in response to the restriction requirement. Species 1.d was elected in the response as required under 35 U.S.C. 121. As will be discussed in more detail below, generic claims are entitled to allowance. Accordingly, claims 1-17 should be considered.

The Examiner notes that there is no mention of traverse in applicant's response to the restriction requirement.

Objections to the specifications are withdrawn in view of amendment. The Examiner notes that applicant refers to an amendment to the disclosures of 5 May 2005. The Examiner believes this refers to the preliminary amendment of 23 July 2003 (amendment to the specification is 24 pages long), which was further amended by applicant's amendment of 2 November 2005 (amendment to the specifications is 12 pages long).

Objections to the drawings are withdrawn in view of amendment. Please note that remarks, page 19, line 2 should refer to paragraph 46, not paragraph 65..

Objections to the claims are withdrawn in view of amendment. The Examiner acknowledges that applicant intends the term "electronic certificate" to mean an electronic document that evidences ownership.

Applicant's comments concerning claim 1 are moot in view of its cancellation.

Concerning Karas and Elliott, Applicant argues,

> ***Karas*** et al. teach an electronic gift greeting which may be used to send to a recipient a payment that may be used to redeem a prepaid phone card (sea paragraph 0019). As taught by ***Karas*** ct al., the recipient must redeem the electronic gift greeting to obtain the prepaid phone card. The prepaid phone card is then used as phone cards are known to be used by interacting directly with telephones equipped to handle the prepaid phone card's....
>
> ***Elliott*** et al. disclose a voice over data telecommunications network architecture. Elliot makes reference to prepaid phone cards...

In response to these arguments, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Concerning claim 2, applicant argues:

> With respect to claim 2, claim 2 is amended to include the subject matter of claim 1 and Applicant respectfully submits that amended claim 2 is neither taught nor suggested by any combination of Karas et al. anti Elliot et al.
>
> Amended claim 2 claims sending a copy of the electronic certificate to the recipient via email using the email address, wherein the electronic certificate includes a call icon used for initiating calls to be charged against the pre-paid call credit associated with the electronic certificate.
>
> Karas et al. teach an electronic gift greeting which may be used to send to a recipient a payment that may be used to redeem a prepaid phone card (sea paragraph 0019). As taught by Karas et al., the recipient must redeem the electronic gift greeting to obtain the prepaid phone card. The prepaid phone card is then used as phone cards are known to be used by interacting directly with telephones equipped to handle the prepaid phone card's.

> Elliott et al. disclose a voice over data telecommunications network architecture. Elliot makes reference to prepaid phone cards but does not teach or suggest an electronic certificate including a call icon for use for initiating calls to be charged against pre-paid call credits. The rejection of claim 2 is thereby respectfully *traver*sed.

In response to these arguments, the Examiner notes that Karas discloses the method and steps claimed in applicant's claim 2, with the exception that Karas does not provide specific examples related to redeeming prepaid ***call*** credits with a [telephone carrier] merchant. Karas discloses applying its invention to prepaid phone cards.

Concerning claim 10, applicant argues:

> With respect to claim 10, claim 10 claims receiving at an application server a call request as a result of an action by the recipient [of the electronic certificate] who activates the call icon.
>
> ...Furthermore, with respect to sending a call request message to a call control node, the referenced text of Elliott et al. in column 140 describes a ***media gateway, well known to those skilled in the art. The media gateway serves as a bridge between a switched telephone network and Internet Protocol network. A media gateway is neither adapted to, nor capable of originating calls*** [emphasis added.]
>
> With respect to the reference to column 2, line 57 to column 3, line 8, the initiation of a call using a telephone connected to an originating end office switch is described. The process is well understood in the art and would not lead any person of ordinary skill in the art to the initiation of a call from a call control node as described in the instant application and claimed in claim 10. The rejection of claim 10 is thereby respectfully *traver*sed.

In response to these arguments, the Examiner notes that claim 10 was modified to remove references to an Internet Protocol Address of a recipient, and that this feature is disclosed, as applicant admits, by the media gateway, which serves as a bridge between a switched telephone network and an Internet Protocol network as previously claimed, and as depicted in applicant's Fig. 1. The Examiner also notes that claim 10 does not refer to ***originating calls*** but to:

> ***...sending*** a call request ***message*** to a call control node in a switched telephone network to instruct the call control node to ***initiate actions*** in the switched telephone network ***to establish*** a telephone connection between the calling telephone number and the called telephone number. (claim 10, Emphasis added)

The Examiner respectfully directs applicant's attention to his abstract, which states, in part,

> An application server receives the request and sends a call request message ***via the Internet*** to ***a virtual switching point*** associated with a switched telephone network. The ***virtual switching point*** initiates actions in the switched telephone network to set up a telephone communication between the recipient and a party to be called.

Concerning claim 14, applicant argues:

> With respect to claim 14, the reference to Elliott et al.at column 1, lines 22-56 is not understood. The referenced text teaches how a switched circuit telephone network reserves a dedicated channel for each call for the duration of the call whether or not any information is actually being transmitted over the channel. This is to illustrate the difference between a switched circuit telephone network and an Internet Protocol data network, which does not reserve dedicated channels for a call because all data transfer is asynchronous.
>
> In any event, no combination of Karas et al. and Elliott et al. teach a call control node, or reporting from the cull control node to the application server a duration of the call after the telephone communication is completed. The rejection of claim 14 is thereby *traver*sed.

As applicant admits in his arguments to Claim 10, these features are old and well known. Again, please refer to applicant's abstract.

Concerning claim 15, applicant argues:

> As per ***claim 15***, Karas et al. do not teach calculating a charge for a telephone call using a cull duration report. The referenced text teaches a transfer fee or a fee charged to a gift certificate target store. This would not lead any person skilled in the art to the claimed limitation. Nor does Karas et al. teach deducting a charge from a remaining value of the credit and updating a remaining value. Karas et al. teach that their electronic gift greeting is "cashed in" in a single transaction. Any charges incurred prior to that transaction or as a result of that transaction are, in accordance with Karas et al., deducted before the transaction in which the recipient receives the gift.
>
> With respect to the teachings of Elliott et al., Elliott et al. teach standard telephone billing procedures implemented in a voice over an Internet Protocol network. Elliott et al. neither teach nor suggest receiving at the application server from the call control node via a data network a call duration report associated with a unique identifier contained in an electronic certificate.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Karas discloses applicant's invention as applied to ***prepaid credits***. Karas suggests its use in ***prepaid phone cards*** [paragraphs 19, 24 and 31]. Applicant has not argued or shown that Karas and Elliott are non-analogous art.

Concerning claim 15, applicant also argues:

> ...Nor does Karas et al. teach deducting a charge from a remaining value of the credit and updating a remaining value. Karas et al. teach that their electronic gift greeting is "cashed in" in a single transaction.
>
> Any charges incurred prior to that transaction or as a result of that transaction are, in accordance with Karas et al., deducted before the transaction in which the recipient receives the gift.

The Examiner disagrees that with applicant's limited reading of Karas and respectfully directs applicant's attention to at least the following, emphasis added:

> [0019]...The prepaid credit or debit cards are backed by a credit card company and are usable like a credit card for purchases ***up to a specified amount***. For example, a $50 MasterCard.TM. prepaid credit card could be issued that is good for any goods or services offered by a merchant that accepts MasterCard.TM. ***until the $50 credit is spent***.
>
> [0024] The promotion handler 160-1 allows ***adding and removing money*** in a form other than legal tender or negotiable instrument. Examples include airline mileage programs, ***prepaid phone cards***.
>
> [0052] ...The stored value fund may be used only once to pay for the present gift or could be ***used any number of times by the receiver*** 130. The stored value fund is identified by the e-mail address of the receiver 130, among other ways.

As to claims 16 and 17, bottom of page 21, these claims remain withdrawn as directed to a non-elected invention. See Election/Restriction Requirement, above.

Prior to concluding this section, the Examiner notes that applicant at times refers to "referenced text" and selected portions of Karas and Elliott. Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the

teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Zurita
Patent Examiner
Art Unit 3625
30 December 2005

Jeffrey A. Smith
Primary Examiner